

Amendments to the Drawings

The drawings labelled Figure 2 and Figure 3 have been amended to include the outermost thickness dimension w. The "w" is added beside two lines with arrows to indicate the dimension of thickness at the outermost edge of the mortarboard.

Support for adding dimension w to the Figures 2 and 3 is found on page 4, lines 4-6. Further, the first two paragraphs of page 7 discuss a "continuously contoured or dished" embodiment of the invention, which is addressed on page 4, first paragraph, as referring to Figures 1-4. The "outermost thickness dimension," referred to in line 17, page 7, is now shown in Figures 2 and 3. The amendment to Figures 2 and 3 is thereby supported. No new matter has been added.

Remarks

Claims 1-28 are pending in the above-referenced application. Claims 1-28 are rejected.

35 USC §112

Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Applicant has amended the specification so as to meet the Examiner's requirement of definiteness. Specifically, "dimension w" has been added to Figures 2 and 3 and also at page 7, line 17.

Support for adding dimension w to the drawing is found on page 4, lines 4-6. Further, the first two paragraphs of page 7 discuss a "continuously contoured or dished" embodiment of the invention, which is addressed on page 4, first paragraph, as referring to Figures 1-4. The "outermost thickness dimension," referred to in line 17, page 7, is now shown in Figures 2 and 3. Claim 1 is now supported. No new matter has been added.

35 USC §103a

Claims 1, 4, 5, 6, 16, and 26 are rejected under 35 U.S.C. §103(a) as being obvious over US 2,615,326 ("Matthews"). Claim 1 is directed to a mortarboard for retaining and carrying mortar, having a holding surface that is continuously contoured in a dished out manner. Claims 4, 5, 6, and 16 are dependent on claim 1. Claim 26 is amended and is now dependent on claim 19; claim 26 will be discussed following discussion of claim 25. The rejection of claims 1, 4, 5, 6, and 16 under 35 U.S.C. §103(a) is respectfully traversed.

In order to establish *prima facie* obviousness, three basic criteria must be met, namely: (1) there must be some suggestion or motivation to modify the reference teaching; (2) there must be a reasonable expectation of success; and (3) the reference must teach or suggest each claim limitation. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986), *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant submits that a *prima facie* case of obviousness has not been established, because Matthews does not teach or suggest each element of the claims. The Examiner asserts that Figure 1 of Matthews discloses a holding surface that is continuously contoured in a dished out manner. However, Figure 1 does not show the top view of the board, i.e. the holding surface,

but rather the bottom view (column 1, lines 24-26). Figure 1 thus contains no information or disclosures regarding anything that could be construed as a holding surface of the board.

In the text of Matthews, the plaster holding surface (10) is repeatedly referred to as a "plate" (column 1 lines 34, 36, 44, 56; column 2, lines 3, 30), "pallet" (claims 1 and 2; column 1, lines 25, 34, 36, 44; column 2, lines 25, 28, 36), or "board" (column 2, lines 25, 28, 36) of the type conventionally used by a plasterer (column 1, lines 34-35), and that is "substantially square in shape" (see column 1, line 37). Figure 1 is described as a combination comprising a "plaster pallet" (column 1, lines 24-26). Figure 2 is a side view of Figure 1 (column 1, lines 27-28) that shows a pallet affixed to handle by a screw. The plaster-holding surface of the plate 10 is flat. There is no disclosure, teaching, or suggestion in Matthews that the board could be modified to include the limitation of a holding surface that is contoured in any manner, let alone a dished out manner, or what advantages might be attained by such a structure.

Further, it would not be obvious to the ordinary skilled mason to modify the teachings of Matthews to include a holding surface contoured according to the claimed invention. In the very long history of masonry, to applicant's knowledge no one has used a board contoured in the present manner. Yet the contour of the board facilitates ease of retempering (rewetting and remixing) the mortar and prevents loss of mortar and water. Because the current invention addresses a problem recognized in the masonry industry, it cannot be said to be obvious in view of Matthews or any other mortarboard configurations known to Applicant.

Accordingly, Applicant submits that Claim 1 is neither disclosed nor rendered obvious by Matthews, and requests reconsideration and withdrawal of the 35 U.S.C. § 103 rejection thereof. Applicant submits that Claims 4, 5, 6, and 16, which depend from claim 1, are also not obvious for those reasons discussed above.

Claim 2 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 2 is directed to the mortarboard of claim 1, further comprising a carrying handle. The Examiner asserts that Matthews discloses the device of claim 1, including a carrying handle. Applicant submits that Matthews does not disclose or teach the invention of claim 2. The arguments presented above regarding claims 1, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Matthews does not teach a mortarboard with a holding surface that is contoured in a dished out manner. The addition of a handle to Matthes does not cure its inherent lack of a dished -out countoured surface. Because claim 2 is dependent on claim 1, and claim 1 is nonobvious, claim 2 is also nonobvious and allowable over Matthews.

Claim 3 is rejected under 35 U.S.C. §103(a) as being obvious over Matthews in light of French patent 1,494,129 ("Wahl"). The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 3 is directed to a handle that is a cut out portion of the material of claim 1, which material itself is substantially flat. The Examiner asserts that Wahl discloses a pallet with a cut out portion of the pallet that forms the handle. Applicant submits that a *prima facie* case of obviousness has not been established. The combination of Matthews with Wahl does not teach or suggest each element of the claim. The arguments presented above regarding claims 1, 2, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Because claim 3 is dependent on claim 1, and claim 1 is nonobvious, claim 3 is also nonobvious.

The Wahl structure is configured to hold discretely positioned and separated paints, and does not have any teachings of a continuously contoured holding surface area for holding mortar. Further, the Wahl structure does not have a cut out portion of the material that forms the handle 7 in Figure 3. Rather, the handle 7, which protrudes beneath the bottom surface of the pallet, is shaped to allow a person to slide a thumb into the shaped protrusion. The handle configuration of Wahl does not teach or suggest a handle that is itself formed from a cut out portion of the material that forms the holding areas.

There is no motivation to modify the handle configuration of Wahl in the manner of the claimed invention, because the function of the handle in Wahl is to allow a painter to hold the paint pallet in a stably horizontal fashion, while the pallet is loaded with paint. The function of the cut out handle of claim 3 is to facilitate carrying of one or more boards vertically, without mortar on their surfaces. One person may thereby easily carry multiple boards. The cut out portion of the mortarboard of the present invention thereby solves the problem of transporting

multiple mortarboards to, from, and around a work site. The handle disclosed in Wahl does not solve this problem, and nothing in Wahl would motivate an ordinarily skilled artisan to modify the teachings of Wahl for the purpose of carrying a mortarboard in a vertical fashion.

Claim 7 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 7 is directed to the mortarboard of claim 1, wherein the holding surface extends out to the side and bottom edges of the board. The Examiner asserts that Matthews discloses this device. For these reasons, Applicant respectfully submits that Matthews does not disclose the device of claim 7. The mortarboard of Matthews discloses a substantially flat holding surface. Because it is substantially flat, the holding surface necessarily extends out to the edges of the board. However, current claim 7 necessarily includes the limitation of a holding surface contoured in a dished out manner. Thus claim 7 claims the contoured portion of the board extending to the side and bottom edges of the material from which the board is formed. There is no disclosure in Matthews regarding a contoured holding surface or its extent to the edges of the material from which the board is formed. Thus Matthews does not teach or suggest each element of the claim. The arguments presented above regarding claims 1, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Further, because claim 7 is dependent on claim 1, and claim 1 is nonobvious, claim 7 is also nonobvious.

Claim 8 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 8 is directed to the mortarboard of claim 7, further comprising a carrying handle. The Examiner asserts that Matthews discloses the device of claim 7, including a carrying handle. Applicants submit that Matthews does not disclose the invention of claim 8, for the reasons cited in the argument above regarding claim 7 and Matthews, which are incorporated here.

Claim 9 is rejected under 35 U.S.C. §103(a) as being obvious over Matthews in light of Wahl. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 9 is directed to a handle that is the cut out portion of the material of claim 8. The Examiner asserts that Wahl discloses a pallet with a cut out portion of the pallet that forms the handle. Applicant submits that a *prima facie* case of obviousness has not been established. The combination of Matthews with Wahl does not teach or suggest each element of the claim. The arguments presented above regarding claim 3 and Matthews and Wahl are incorporated here.

Further, because claim 9 is dependent on claim 8, and claim 8 is nonobvious, claim 9 is also nonobvious.

Claim 10 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 10 is directed to the mortarboard of claim 1, further comprising raised peripheral lip portions at the sides and bottom of the holding surface. Contrary to the Examiner's assertions, Matthews does not disclose raised peripheral lip portions as part of his plate 10 in Figure 2. Nothing in Matthews mentions or suggests raised peripheral lip portions on the pallet. The arguments above regarding claims 1, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Further, because claim 10 is dependent on claim 1, and claim 1 is nonobvious, claim 10 is also nonobvious.

Claim 11 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 11 is directed to the mortarboard of claim 10, further comprising raised peripheral lip portions that are raised from the holding surface by less than 0.5 inch. The Examiner asserts that Matthews discloses the device of claim 11, and that it would be obvious to place the raised lips within 0.5 inches of the holding surface so as to carry out the intended purpose of holding the mortar on the holding surface. As stated in the preceding paragraph, Matthews does not disclose or suggest any raised peripheral lip portions, and therefore has no disclosures or teachings as to why one would provide raised lip portions of any specific height. Matthews further does not disclose the invention of claim 11 for the reasons cited in the argument above regarding claim 10 and Matthews, which is incorporated here.

Claim 12 is rejected under 35 U.S.C. §103(a) as being obvious over Matthews in light of US 2,880,423 ("O'Reilly"). The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 12 is directed to the mortarboard of claim 1, further comprising a bottom portion having supporting ribs formed integrally with the material. The Examiner asserts that the mortarboard cap of O'Reilly, which comprises ribs formed integrally with the material of the cap, renders the use of ribs in the mortarboard of the current invention obvious to one skilled in the art of masonry. Applicant submits that a *prima facie* case of obviousness has not been established. The combination of Matthews with O'Reilly does not teach or suggest each element of the claim. The arguments presented above regarding claims 1, 4, 5, 6, 16, and 26 and

Matthews are incorporated here. Because claim 12 is dependent on claim 1, and claim 1 is nonobvious, claim 12 is also nonobvious.

Further, nothing in the prior art suggests the desirability of combining Matthews with O'Reilly to reach the invention described in Claim 12. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the combined references or prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The art of designing adequate support for clothing or headwear cannot be said to be an art analogous to the art of designing adequate support for a holding surface for masonry materials; thus Applicant submits that there is no suggestion of the desirability of the combination. The structure of O'Reilly may be called a mortarboard, but that is where any similarity to the claimed invention ends. The O'Reilly structure cannot function and is not designed to function as a device for retaining and carrying mortar. It is simply a decorative hat.

Claim 13 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 13 is directed to the mortarboard of claim 1, further comprising a bottom surface that is designed to accommodate a support stand. The Examiner asserts that Matthews discloses the device of claim 13 (column 2, lines 45-50). Applicant submits that Matthews does not disclose the invention of claim 13, because Matthews does not teach or suggest each element of the claim. The arguments presented above regarding claims 1, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Because claim 13 is dependent on claim 1, and claim 1 is nonobvious, claim 13 is also nonobvious.

Further, Matthews column 2, lines 45-50 describes a plurality of spaced posts that are secured to the pallet (the plaster holding surface) for the purpose of holding a lower plate away from the pallet. There is no disclosure or teaching in Matthews that his spacer posts and lower plate combine, or should be combined, to form a support stand for the pallet. Their function is to retainably hold a roll of tape.

Claims 14 and 15 are rejected under 35 U.S.C. §103(a) as being obvious in light of Matthews in light of US 5,067,761 ("Blowers"). The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claims 14 and 15 are directed to the mortarboard of claim 1, made from a polymeric material (claim 14) or having a holding surface area formed from a polymeric material (claim 15). The Examiner asserts that the mortar hawk of Blowers is disclosed as being made from plastic, and that this disclosure renders obvious the limitation of making a plastic mortarboard of the present invention. Applicant submits that a *prima facie* case of obviousness has not been established. The combination of Matthews and Blowers does not teach or suggest each element of the claim. The arguments presented above regarding claims 1, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Because claims 14 and 15 are dependent on claim 1, and claim 1 is nonobvious, claims 14 and 15 are also nonobvious.

Claim 17 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 17 is directed to the mortarboard of claim 1, further comprising the limitation of having a rectangular shape. The Examiner asserts that Matthews discloses the device of claim 17 in Figure 1. Applicant respectfully submits that Matthews does not disclose the invention of claim 17, because Matthews does not teach or suggest each element of the claim. The arguments presented above regarding claims 1, 4, 5, 6, 16, and 26 and Matthews are incorporated here. Because claim 17 is dependent on claim 1, and claim 1 is nonobvious, claim 17 is also nonobvious.

Claim 18 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. The rejection under 35 U.S.C. §103(a) is respectfully traversed.

Claim 18 is directed to the mortarboard of claim 1, further comprising material configured so that a front and a rear surface of the material will nest together when more than one mortarboards are stacked together. The Examiner asserts that Matthews discloses the device of claim 18. Applicant respectfully submits that Matthews does not disclose the invention of claim 18, because Matthews does not teach or suggest each element of the claim. The arguments presented above regarding claim 1 and Matthews are incorporated here. Because claim 18 is dependent on claim 1, and claim 1 is nonobvious, claim 18 is also nonobvious.

Applicant is at a loss to understand how two Matthews type devices could nest together as recited in claim 18. In Matthews Figure 2, a handle is shown protruding perpendicularly from the pallet (mortar holding surface). The handle would preclude nesting of boards by holding the boards apart in an "unnested" configuration. Matthews neither teaches nor suggests any nesting

or stacking of boards, because the handle is an integral aspect of the invention and prevents nesting (see e.g. Matthews, Figures 1 and 2, claims 1 and 2).

Claim 19 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. Applicant has amended the claim to even more clearly define his invention.

Claim 19, as amended, recites a mortarboard "wherein the material defines a cut-out area portion configured to form a carrying handle." The Examiner asserts that "a handle" is disclosed by Matthews. A handle that is formed by a cut-out portion of the mortarboard material is not taught or suggested by Matthews.

There is no motivation to modify the handle configuration of Matthews in the manner of the current invention, because the a function of the handle in Matthews is to allow a mason to hold the mortar holding surface of the pallet in a stably horizontal fashion, while the pallet is loaded with mortar. A second function of the handle is to hold a roll of tape. A handle formed by cutting from the material of the mortarboard itself would accomplish neither of these aspects of the Matthews handle.

In contrast, the function of the cut out handle of claim 19 is to facilitate carrying of one or more boards vertically, without mortar on their surfaces. One person may thereby easily carry multiple boards. The cut out portion of the mortarboard of the present invention thereby solves the problem of transporting multiple mortarboards to, from, and around a work site. The handle disclosed in Matthews does not solve this problem, and nothing in Matthews would motivate an ordinarily skilled artisan to modify the teachings of Matthews for the purpose of carrying a mortarboard in a vertical fashion.

Claim 20 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. Applicant has amended the claim. Claim 20 is now dependent on claim 19, which is nonobvious. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claim 20 is dependent on claim 19, and claim 19 is nonobvious, claim 20 is also nonobvious.

Claim 21 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. Claim 21 is dependent on claim 19, which is nonobvious. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claim 21 is dependent on claim 19, and claim 19 is nonobvious, claim 21 is also nonobvious.

Claim 21 is directed to the mortarboard of claim 1, further comprising raised peripheral lip portions at the sides and bottom of the holding surface. The Examiner asserts that Matthews

discloses the device of claim 10, including raised peripheral lip portions. Applicant respectfully submits that Matthews does not disclose the invention of claim 10, because Matthews does not disclose raised peripheral lip portions either in the drawings or the text of the patent. Nothing in Matthews teaches or suggests raised peripheral lip portions on the pallet.

Claim 22 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. Applicant has amended the claim. Claim 22 is now dependent on claim 21, which requires raised lip portions. The arguments presented above regarding claim 21 and Matthews are incorporated here. Because claim 22 is dependent on claim 21, and claim 21 is nonobvious, claim 22 is also nonobvious.

Claim 23 is rejected under 35 U.S.C. §103(a) as being obvious in light of Matthews in light of O'Reilly. Applicant has amended the claim to depend on claim 19. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claim 23 is dependent on claim 19, and claim 19 is nonobvious, claim 23 is also nonobvious.

Claim 23, as amended, is directed to the mortarboard of claim 19, further comprising the limitation of supporting ribs formed integrally with the material. The Examiner asserts that the mortarboard cap of O'Reilly, which comprises ribs formed integrally with the material of the cap, renders the use of ribs in the mortarboard of the current invention obvious to one skilled in the art of masonry. Applicant submits that the combination of Matthews with O'Reilly does not teach or suggest each element of the claim. The arguments presented above with regard to claim 12 and O'Reilly are incorporated here.

Claims 24 and 25 are rejected under 35 U.S.C. §103(a) as being obvious in light of Matthews in light of Blowers. Claims 24 and 25 are now dependent on claim 19, which is nonobvious. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claims 24 and 25 are dependent on claim 19, and claim 19 is nonobvious, claims 24 and 25 are also nonobvious.

Claim 26 is rejected under 35 U.S.C. §103(a) as being obvious over Matthews. Applicant has amended the claim. Claim 26 is now dependent on claim 19, which is nonobvious. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claim 26 is dependent on claim 19, and claim 19 is nonobvious, claim 26 is also nonobvious.

Claim 27 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. Applicant has amended the claim. Claim 27 is now dependent on claim 19. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claim 27 is dependent on claim 19, and claim 19 is nonobvious, claim 27 is also nonobvious.

Claim 28 is rejected under 35 U.S.C. §103(a) as being disclosed by Matthews. Applicant has amended the claim. Claim 28 is now dependent on claim 19. The arguments presented above regarding claim 19 and Matthews are incorporated here. Because claim 28 is dependent on claim 19, and claim 19 is nonobvious, claim 28 is also nonobvious.

Claim 28 is directed to the mortarboard of claim 19, further comprising material configured so that a front and a rear surface of the material will nest together when more than one mortarboards are stacked together. As discussed above, two Matthews type devices could nest together. The arguments presented above regarding claim 18 and Matthews are incorporated here.

Response to Arguments

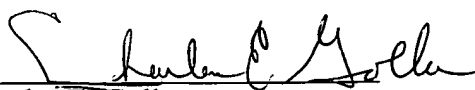
For the reasons recited above, Applicant respectfully submits that the presently pending claims of the above-referenced application are patentable over the cited references.

Reexamination and consideration of the application with entry of the currently submitted amendments is requested, and allowance of claims 1-28 at an early date is respectfully solicited.

If the Examiner has any questions regarding this amendment of the invention, in an effort to expedite prosecution of this applications, she is respectfully requested to call the undersigned to discuss any questions or issues she may have.

Respectfully submitted,

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